



PATENT  
Customer No. 22,852  
Attorney Docket No. 3806-0488-00

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Application of:	)	
	)	
Christian VISKOV	)	Group Art Unit: 1653
	)	
Application No.: 09/742,008	)	Examiner: Kam, C.
	)	
Filed: December 22, 2000	)	
	)	
For: NOVEL PROCESS FOR	)	
PREPARING CYCLOSPORIN	)	
DERIVATIVES	)	

**Mail Stop Petition**  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

**RENEWED PETITION UNDER 37 C.F.R. § 1.137(b)**

The above-identified application became abandoned for the unintentional failure to file a timely response to the Office Action mailed on June 25, 2003. The Patent Office mailed a Notice of Abandonment March 12, 2004, following an Examiner Interview with Applicant's attorney of record, who confirmed that a response had not been filed to the June 25, 2003, Office Action.

Applicant filed a "Petition for Revival of an Application for Patent Abandoned Unintentionally Under 37 C.F.R. § 1.137(b)" on June 17, 2004. (Exhibit A.) The Office mailed a Decision on Petition (Paper No. 9) on October 28, 2004 (Exhibit B), dismissing Applicant's petition for allegedly failing to satisfy requirement (3) of 37 C.F.R. § 1.137(b), which states:

(3) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional. The Director may require additional information where there is a question whether the delay was unintentional;

In the Decision, the Office requested further information "before a conclusion that the delay was unintentional can be reached." Specifically, the Office requested copies of the correspondence identified in Applicant's Petition filed June 17, 2004, which was relied upon to demonstrate that the delay was unintentional. (See Exhibit B at p. 2.)

Accordingly, Applicant is filing a Renewed Petition under 37 C.F.R. § 1.137(b) in response to the Decision dismissing Applicant's originally-filed Petition for Revival, which Decision was mailed October 28, 2004, the period for filing a Renewed Petition having been extended for one month by the request for extension and fee payment filed concurrently herewith. The circumstances surrounding the misunderstanding between the Applicant and their U.S. representatives that resulted in the unintentional abandonment of this application were previously explained in Applicant's originally-filed petition, but will be repeated here, together with citation to the attached copies of correspondence relied upon to demonstrate that Applicant's abandonment of this application was unintentional. In addition to the two letters specifically requested by the Office, Applicant has provided copies of additional correspondence that places the circumstances surrounding the misunderstanding between Applicant and the Applicant's attorney of record into context. Furthermore, a Declaration by Mr. François David, the patent attorney of assignee Aventis responsible for this application during the relevant time period, is also submitted with this Renewed Petition, and demonstrates that Applicant's abandonment of this application was unintentional. (Exhibit C at ¶¶ 1-3.)

As represented in Applicant's originally-filed petition, the failure to file a timely response to the outstanding Office Action of June 25, 2003, and the resultant abandonment of this application by the Applicant was wholly unintentional. Applicant has worked diligently to explain and correct the unintentional abandonment from the time they learned of the abandonment to the filing of their original petition, as well as this renewed petition and accompanying papers. (*Id.* at ¶ 15.) Thus, the entire delay in filing the required reply, from the due date for the response to the Office Action of June 25, 2003, until the filing of this renewed petition, was unintentional. Applicant presents the following explanation in support of this statement.

In late 2002, Mr. François David, a patent attorney for assignee Aventis, became responsible for several of Aventis' applications in the anti-infective and anti-viral area, including this application, when the previously responsible Aventis patent attorney within his department left the company. (*Id.* at ¶¶ 1-3.) At this time, Mr. David took over responsibility for several applications that originated with Rhône-Poulenc Rorer (the company that his prior employer, Hoechst Marion Roussel, merged with) and with which he was not familiar. (*Id.*)

On June 9, 2003, the undersigned sent a letter to Mr. David that reported an oral restriction requirement communicated by the U.S. patent examiner, and requested instructions from the Applicant on how to proceed. (*Id.* at ¶ 4, Exhibit 1.)<sup>1</sup> According to Mr. David, this was his first experience with this application. (*Id.*) When Mr. David received the June 9, 2003, letter, he reviewed Aventis' computer database in order to determine the status of the application and what, if any, action to take in response to the

June 9, 2003, letter. (*Id.* at ¶ 5.) It was Mr. David's understanding at the time that the application may have been previously abandoned. (*Id.*) In view of the recent merger that created Aventis, and Mr. David's unfamiliarity at that time with the database containing the information concerning this application formerly owned by the assignee's predecessor, it was difficult for Mr. David to determine the accuracy of the database contents. (*Id.* at ¶¶ 1, 6.) Moreover, he could not independently confirm whether the database information was accurate because their file for this application was stored off-site at the time. (*Id.* at ¶ 6.)

Because he could not verify whether this application had been abandoned, Mr. David, with some hesitation, sent the undersigned an e-mail dated June 13, 2003, in which he referred to instructions from November 2002, which he understood at the time to have been sent to Applicant's representative and to state that Aventis was willing to abandon the application. (*Id.* at ¶ 7, Exhibit 2.) Mr. David also stated in his e-mail, however, that he did not have access to the file nor had he seen a copy of the alleged November 2002 instructions, and requested that Applicant's representatives check their file and inform him concerning the existence of such instructions. (*Id.*)

Further to these written instructions, which were initially understood by Applicant's attorney of record to suggest that there may have been a prior instruction to allow this application to go abandoned, the undersigned internally closed the application matter and informed the Applicant of such closure on June 13, 2003. (*Id.* at ¶ 10, Exhibit 4.) Since no response to the undersigned's June 13, 2003, letter was received from the Applicant indicating this application was to instead be maintained, the

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<sup>1</sup> References to Exhibits by number refers to the numbered Exhibits attached to

undersigned did not forward to the Applicant, nor otherwise take any action when the June 25, 2003, Office Action was received. To the best of the undersigned's knowledge, no further action occurred related to this matter in 2003.

On March 16, 2004, the undersigned received from the Office a Notice of Abandonment for this application dated March 12, 2004. The Notice of Abandonment was forwarded to the Applicant on March 24, 2004. (Exhibit D.) Upon receiving the Notice of Abandonment, Mr. David immediately reviewed his file for this application and promptly responded to the undersigned on April 8, 2004, in which response he indicated that his files included no indication of any intention to abandon the application, nor any formal letter instructing such action. (Exhibit C at ¶ 9, Exhibit 3.) Mr. David also indicated that the last official USPTO correspondence in his file was a Status Inquiry filed in the USPTO on September 20, 2002, and that he had no record of ever receiving the official Office Action of June 25, 2003. (*Id.*) According to Mr. David, the last communication received from Applicant's attorney of record before the Notice of Abandonment was the June 9, 2003, letter discussing the Examiner's oral restriction requirement. (*Id.* at ¶ 8.)

In response to the Applicant's correspondence of inquiry and concern, Applicant's attorney of record responded on April 13, 2004, identifying and providing copies of the relevant e-mail of general instruction relied upon and the relevant letter in which the Applicant's attorney of record confirmed that he had no record of any November 2002 correspondence instructing Applicant's attorney of record to abandon the application. (*Id.* at ¶ 10, Exhibit 4.) Furthermore, the letter from Applicant's attorney

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Exhibit C, Declaration of François David.

of record stated that he would be abandoning the application according to Mr. David's instruction. (*Id.*)

That same day, April 13, 2004, Mr. David sent the Applicant's attorney of record an e-mail stating that he never received the undersigned's June 13, 2003, letter confirming that the application was going to be abandoned, nor did he find any correspondence in his file for this application instructing Applicant's attorney of record to abandon the application, including the alleged November 2002 instructions. (*Id.* at ¶ 11.) Mr. David also stated that it was Aventis' clear desire to revive this application and continue prosecution as this application should never have been abandoned. (*Id.*)

It is Mr. David's belief that the merger that created Aventis led, in part, to his not receiving the undersigned's June 13, 2003, letter, which confirmed that the application was going to be abandoned. (*Id.* at ¶¶ 1, 12.) Because of logistic difficulties related to the merger, members of Aventis' patent department were not all located in one place and at the time, Aventis was having difficulties with routing incoming facsimile transmissions to the appropriate recipients. (*Id.* at ¶ 12.) In fact, at the time, Mr. David was physically located in a different place than the location of the Aventis patent attorney that was formerly handling this application before he assumed responsibility. (*Id.*) As a result, it is Mr. David's belief that the June 13, 2003, letter from Applicant's attorney of record was misdirected within Aventis' patent department and never reached him. (*Id.*)

As can be seen from the attached exhibits and those attached to the concurrently filed Declaration of François David, the correspondence between the Applicant and the

undersigned demonstrates that the abandonment of this application was unintentional on the part of the Applicant, as defined by 37 C.F.R. § 1.137(b).

*In re Maldague*, 10 USPQ2d 1477 (Comm'r Pat. & Trademarks 1989), supports the USPTO's acceptance of Applicant's demonstration that this application was abandoned unintentionally. In *In re Maldague*, the assignee's patent agent instructed its U.S. counsel not to respond to an Office Action, because the patent agent "concluded that the rejection was reasonable and that there was no possibility of successfully defending against it." *Id.* at 1478. The application was abandoned for failing to respond to the Office Action. *Id.* The patent agent, however, later realized that his conclusion was in error and filed a Petition to Revive. *Id.*

In denying that Petition to Revive, the Commissioner noted that the record establishes that the assignee "deliberately chose not to respond" to the Office Action. *Id.* The Commissioner recognized, however, that a "distinction must be made between a mistake of fact, which may form the basis for a holding of unintentional abandonment under 37 C.F.R. 1.137(b), and the arrival at a different conclusion after reviewing the same facts a second time." *Id.* Here, we clearly have an example of a mistake in fact, which supports the basis for a holding of unintentional abandonment. Were it not that Applicant's attorney of record misinterpreted Applicant's June 13, 2003, e-mail as an instruction to abandon this application (i.e., a mistake of fact) and Applicant failed to receive the undersigned's letter confirming that the application was going to be abandoned, a response to the Office Action would have been filed in a time period during which a response would have been timely. (Exhibit C at ¶¶ 13-14.) Moreover, unlike *In re Maldague*, neither Mr. David nor assignee Aventis "deliberately chose not to

respond" to the Office Action, nor was then ever any affirmative decision on behalf of assignee Aventis not to continue the prosecution of this application. (*Id.* at ¶ 14.)

Accordingly, Applicant hereby renews its originally-filed petition for revival of this application.

In addition, Applicant submits a response to the outstanding Office Action dated June 25, 2003, in the form of a Response to Restriction Requirement, which was also submitted with Applicant's originally-filed June 17, 2004, Petition.

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the application, any patent issuing thereon, or any patent to which this verified statement is directed.

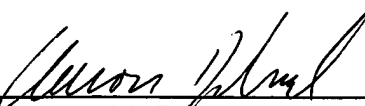
If there are any other fees due in connection with the filing of this response, including any fees required for an extension of time under 37 C.F.R. § 1.136, such an extension is requested, and the Commissioner is authorized to charge any related fees to our Deposit Account No. 06-0916.

Respectfully submitted,

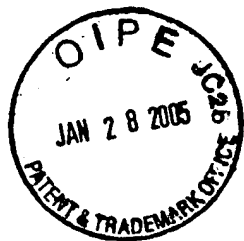
FINNEGAN, HENDERSON, FARABOW,  
GARRETT & DUNNER, L.L.P.

Dated: January 28, 2005

By: \_\_\_\_\_

  
Aaron M. Raphael  
Reg. No. 47,885





# EXHIBIT A



TUI - SSS - AMR

**PLEASE STAMP TO ACKNOWLEDGE RECEIPT OF THE FOLLOWING:**

9

In Re Application of: Christian VISKOV

Application No.: 09/742,008

Group Art Unit: 1653

Filed: December 22, 2000

Examiner: Kam, C.

For: NOVEL PROCESS FOR PREPARING CYCLOSPORIN DERIVATIVES

- 
1. Petition for Revival of an Application for Patent Abandoned Unintentionally Under 37 C.F.R. § 1.137(b) (3 pages).
  2. Response to Restriction Requirement (3 pages).
  3. Check for \$1,330.00.



Date: June 17, 2004

Docket No.: 03806.0488-00000

AMR/dew: Please return to Aaron Raphael - MD 1020

pkts  
6-17-04  
WTH



PATENT

Customer No. 22,852

Attorney Docket No. 3806-0488-00

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Christian VISKOV

Application No.: 09/742,008

Filed: December 22, 2000

For: NOVEL PROCESS FOR  
PREPARING CYCLOSPORIN  
DERIVATIVES

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)  
) Group Art Unit: 1653  
)  
) Examiner: Kam, C.  
)  
)  
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)  
)

**Mail Stop Petition**

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

Sir:

**PETITION FOR REVIVAL OF AN APPLICATION FOR PATENT  
ABANDONED UNINTENTIONALLY UNDER 37 C.F.R. § 1.137(b)**

The above-identified application became abandoned for failure to file a timely and proper response to the Office Action mailed on June 25, 2003. The abandonment date of this application was December 26, 2003 (i.e., the day after the expiration date of the period set for response plus any extensions of time obtained therefore). The Patent Office mailed a Notice of Abandonment March 12, 2004, following an Examiner Interview with Applicant's attorney of record, who confirmed that a response had not been filed to the June 25, 2003, Office Action.

The failure to file a timely response to the outstanding Office Action and the resultant abandonment of this application by the Applicant was unintentional. Applicant

has worked diligently to explain and correct the abandonment from the time they learned of the unintentional abandonment to the filing of this Petition and accompanying papers. Thus, the entire delay in filing the required reply, from the due date for the reply until the filing of this petition, was unintentional. Applicant presents the following facts in support of this statement.

Further to written instructions from the Applicant, which were believed to instruct Applicant's attorney of record to allow this application to go abandoned, the undersigned formally closed the application matter and informed the Applicant of such closure. Since no response was received from Applicant indicating this application to be maintained, when the June 25, 2003, Office Action was received, it was not acted upon, including not forwarded to the Applicant.

On March 12, 2004, the undersigned received from the Office a Notice of Abandonment. The Notice included an Interview Summary from an interview with the undersigned's supervisor on February 6, 2004, indicating the application had been abandoned. The Notice of Abandonment was forwarded to the Applicant, who promptly responded to the undersigned that the Applicant's files included no indication of any intention to abandon the application, nor any formal letter instructing such action. In response to the Applicant's correspondence of inquiry and concern, Applicant's attorney of record responded, identifying the relevant letter of general instruction relied upon. Shortly thereafter, the Applicant sent a letter clearly stating that there was a misunderstanding between the Applicant and the undersigned and that there was never any intention on behalf of the Applicant to abandon the application. Accordingly, the Applicant's abandonment was unintentional, as defined by 37 C.F.R. § 1.137(b).

Applicant hereby petitions for revival of this application since it was unintentionally abandoned. The petition fee as set forth in 37 C.F.R. § 1.17(m) of \$1,330.00 is enclosed.

In addition, Applicant submits a response to the above-identified Office Action in the form of a Response to Restriction Requirement.

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the application, any patent issuing thereon, or any patent to which this verified statement is directed.

If there are any other fees due in connection with the filing of this response, including any fees required for an extension of time under 37 C.F.R. § 1.136, such an extension is requested, and the Commissioner is authorized to charge any related fees to our Deposit Account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,  
GARRETT & DUNNER, L.L.P.

Dated: June 17, 2004

By: 

Aaron M. Raphael  
Reg. No. 47,885



## EXHIBIT B



UNITED STATES PATENT AND TRADEMARK OFFICE

TLI/AMR

3806.488

Commissioner for Patents  
United States Patent and Trademark Office  
P.O. Box 1450  
Alexandria, VA 22313-1450  
www.uspto.gov

FINNEGAN, HENDERSON, FARABOW,  
GARRETT & DUNNER LLP  
1300 I STREET, NW  
WASHINGTON, DC 20005

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Paper No. 9

COPY MAILED

OCT 28 2004

FINNEGAN, HENDERSON, FARABOW,  
GARRETT AND DUNNER, LLP

In re Application of  
Christian Viskov  
Application No. 09/742,008  
Filed: December 22, 2000  
Atty Docket No. 03806.0488-00000

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OFFICE OF PETITIONS  
DECISION ON PETITION

This is a decision on the "PETITION FOR REVIVAL OF AN APPLICATION FOR PATENT ABANDONED UNINTENTIONALLY UNDER 37 C.F.R. § 1.137(b)," filed June 17, 2004.

The petition is **DISMISSED**.

Any request for reconsideration of this decision must be submitted within **TWO (2) MONTHS** from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 CFR 1.137(b)." No additional petition fee is required.

The above-identified application became abandoned for failure to timely file a proper response to the Restriction Requirement mailed June 25, 2003. This Notice set a thirty-day time limit for reply. No extensions of time to reply under the provisions of 37 CFR 1.136(a) were obtained. Accordingly, the above-identified application became abandoned on July 26, 2003. A Notice of Abandonment was mailed on March 12, 2004.

A grantable petition pursuant to 37 CFR 1.137(b) must be accompanied by:

(1) the reply required to the outstanding Office action or notice, unless previously filed;

(2) the petition fee as set forth in 37 CFR 1.17(m);

(3) a statement that the **entire** delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional. The Director may require additional information where there is a question whether the delay was unintentional; and

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(4) any terminal disclaimer (and fee as set forth in §1.20(d)) required pursuant to 37 CFR 1.137(d).

The instant petition does not satisfy requirement (3) above.

Given the circumstances of the abandonment, as set forth on petition, further information is required before a conclusion that the delay was unintentional can be reached. Specifically, petitioner indicates that there was a misunderstanding between applicant and their attorneys as to a letter of general instruction and that there was never any intention on behalf of the applicant to abandon the application. However, in support thereof, petitioner submits neither the referenced letter of instruction or the letter clearly stating the misunderstanding. It is requested that petitioner provide copies of the relevant letters to support a conclusion that the delay was unintentional within the meaning of § 1.137(b).

Further correspondence with respect to this decision should be addressed as follows:

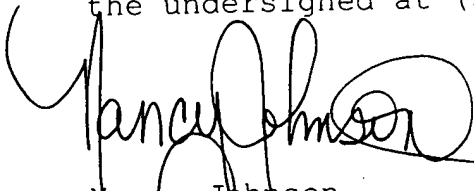
By mail: Mail Stop Petition  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

By FAX: (703) 872-9306  
ATTN: NANCY JOHNSON  
SENIOR PETITIONS ATTORNEY

By hand: Effective June 5, 2004, patent correspondence delivered by hand or delivery services, other than the USPS, to the Customer Window must be addressed as follows:

U.S. Patent and Trademark Office  
220 20th Street S.  
Customer Window, Mail Stop  
Crystal Plaza Two, Lobby, Room 1B03  
Arlington, VA 22202

Telephone inquiries related to this decision may be directed to the undersigned at (571) 272-3219.



Nancy Johnson  
Senior Petitions Attorney  
Office of Petitions



# EXHIBIT C





PATENT  
Customer No. 22,852  
Attorney Docket No. 3806-0488-00

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Application of: )  
Christian VISKOV ) Group Art Unit: 1653  
Application No.: 09/742,008 ) Examiner: Kam, C.  
Filed: December 22, 2000 )  
For: NOVEL PROCESS FOR )  
PREPARING CYCLOSPORIN )  
DERIVATIVES )

**Mail Stop Petition**  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

**DECLARATION OF FRANÇOIS DAVID**

**IN SUPPORT OF RENEWED PETITION TO REVIVE FOR  
UNINTENTIONAL ABANDONMENT UNDER 37 C.F.R. § 1.137(b)**

I, François David, submit this Declaration in support of the concurrently filed Renewed Petition to Revive this application for its unintentional abandonment for the delay in responding to the Office Action mailed on June 25, 2003.

1. I am currently employed by Aventis Pharma S.A. ("Aventis") and hold the position of Director in the Patent Department. I have worked in the Patent Department of Aventis since its creation in 2000. Prior to the corporate merger resulting in Aventis, I worked as a patent attorney with various of its predecessor companies, and have done so since the early

1970s, including, most recently, Hoechst Marion Roussel, which merged with Rhône-Poulenc Rorer ("RPR") to produce the currently existing Aventis.

2. Since its filing in December 2000 to the present, Aventis has been the assignee of U.S. Application No. 09/742,008, entitled "Novel Process for Preparing Cyclosporin Derivatives," demonstrated by the assignment from the inventor, which was recorded at Reel 011767, Frame 0532, on May 2, 2001. U.S. Application No. 09/742,008 is a continuation of PCT International Application No. PCT/FR99/01480, filed June 21, 1999, which claimed priority benefit of French Patent Application No. 98/07846, filed June 22, 1998, by RPR.

3. Sometime in late 2002, I became responsible for several of Aventis' applications in the anti-infective and anti-viral area, including this application, Application No. 09/742,008, when the previously responsible RPR patent attorney (who, upon merger, became an Aventis patent attorney) within my department left the company. At this time, I became responsible for some RPR-originating applications.

4. My first experience with this application occurred on or about June 9, 2003, when I received a letter from Aventis' outside counsel responsible for prosecuting this application, i.e., Applicant's representatives, reporting an oral restriction requirement communicated by the Examiner. (Exhibit 1.) I believe this letter was directed to me because I recently had taken over responsibility for this application formerly handled by my colleague.

5. After considering the letter from Applicant's representatives of June 9, 2003, I reviewed our merged computer database and the materials that were readily available to me in order to determine the status of the application and what action, if any, to take in response to the letter. Initially, the database appeared to me to indicate that this application could have been previously abandoned. Based upon my review of the readily available materials at the time, it

was my understanding that Aventis may have provided to some of its international prosecution counsel responsible for this application instructions in November 2002 indicating that Aventis was willing to proceed with abandonment. It was not clear from my review, however, whether Applicant's U.S. representatives received such an instruction.

6. In view of the recent merger, and my unfamiliarity at that time with the database containing information concerning this application formerly owned by RPR, it was difficult to determine the accuracy of the database contents. Moreover, I was not able to independently confirm whether the information from the database was accurate because our file for this application was stored off-site at the time.

7. Since I could not confirm whether this application was to be or had been abandoned and in view of my unfamiliarity with all of the details surrounding this application, I responded to Applicant's representatives' June 9, 2003, letter by e-mail on June 13, 2003, with some hesitation. (Exhibit 2.) In my e-mail, I referred to instructions from November 2002, which I understood may have been sent at the time to Applicant's representatives and to state that Aventis was willing to abandon this application. (*Id.*) As my e-mail states, however, I did not have access to the file nor had I seen a copy of the November 2002 instructions. (*Id.*) Accordingly, I requested that Applicant's representatives check their own file and keep me informed concerning the existence of such instructions. (*Id.*)

8. I was not provided nor was I aware of another communication from Applicant's representatives regarding this application until March 24, 2004, when I received a copy of the Notice of Abandonment dated March 12, 2004, which indicated that this application had been abandoned for failure to timely respond to the Office Action of June 25, 2003.

9. I immediately retrieved and reviewed our file for this application in order to determine why this application had been abandoned. A Status Inquiry filed in the USPTO on September 20, 2002, was the last official USPTO correspondence in our file for this application. We had no record of the Office Action of June 25, 2003, identified in the Advisory Action. I then wrote an e-mail to outside counsel on April 8, 2004, in which I indicated that we had received a copy of the Status Inquiry but had never received the June 25, 2003, Office Action. (Exhibit 3.) I questioned why we had not responded to the Office Action, since our file for this application did not contain any instruction from Aventis to abandon the application. (*Id.*) I also indicated that this application had importance as it was my understanding at the time that I wrote my April 8, 2004, e-mail that Aventis was in the middle of licensing negotiations with a third party regarding several patents and applications, including this application. (*Id.*) It is also my present understanding that this application has had importance for Aventis since at least the filing date of this application. I am furthermore not aware of any information to the contrary.

10. Applicant's representatives responded by e-mail on April 13, 2004, describing the events leading up to why no response to the Office Action was filed and explaining the possibility of reviving the application. Applicant's representatives attached copies of previously exchanged correspondence from their file for this application, including my e-mail of June 13, 2003 (Exhibit 2), which was apparently mistakenly interpreted to be an instruction by me to abandon this application. Also attached was a June 13, 2003, letter sent by outside counsel to me, which responded to my e-mail of June 13, 2003, and, in relevant part, stated:

We have no record of your November 2002 correspondence indicating that you requested that the application be abandoned. Further to your instruction in your email, however, we will update our docket to reflect that we will be abandoning the above-identified application.

(Exhibit 4.)

11. That same day, April 13, 2004, I replied to Applicant's representatives informing them that I was never given their letter of June 13, 2003, nor did we (i.e., Aventis) have any record of receiving it. Furthermore, I clearly informed Applicant's representatives that I found no correspondence in our file for this application instructing them to abandon this application and was surprised that it was abandoned. I further indicated our clear desire to revive this application and continue prosecution as this application was never intended to have been abandoned.

12. I believe that the merger that created Aventis led, in part, to my not receiving the June 13, 2003, letter from Applicant's representatives. Because of logistical difficulties related to the merger, members of Aventis' patent department were not all located in one place and at the time, we were having difficulties with routing incoming facsimile transmissions to the appropriate recipients. In fact, at the time, I was physically located in a different place than the location of the Aventis patent attorney that was formerly handling this application before I assumed responsibility. As a result, it is my belief that the June 13, 2003, letter from Applicant's representatives was misdirected within our patent department and never reached me.

13. Thus, it is my belief that this application was mistakenly abandoned because (1) I did not fully comprehend this complex situation when I originally reviewed the database materials that were readily available to me in late 2002, (2) my June 13, 2003, e-mail was misinterpreted as an instruction to abandon the case, (3) I never received, nor do we (i.e., Aventis) have any record of, Applicant's representatives' June 13, 2003, letter indicating that they had no record of a November 2002 letter stating that we were willing to abandon the application but that, pursuant to our instruction, were going to abandon this application, and (4)

we never received the official, written Office Action of June 25, 2003, in a time period during which a response would have been timely.

14. Clearly, as explained above and as shown by the attached copies of correspondence, the delay in responding to the June 25, 2003, Office Action was not a result of a deliberately chosen course of action by me or Aventis, the assignee of this application. Nor was there ever an affirmative decision on behalf of Aventis not to continue the prosecution of this application. In fact, if we had received either the June 13, 2003, letter, in which Applicant's representatives informed us that the application was going to be abandoned, or the Office Action of June 25, 2003, I would have reviewed the appropriate materials and instructed Applicant's representatives that Aventis did not want to abandon this application and that counsel should respond to the Office Action within the required time period. Accordingly, the entire delay in responding to the Office Action from the date a response was due until the filing of the "Petition for Revival of an Application for Patent Abandoned Unintentionally Under 37 C.F.R. § 1.137(b)," filed June 17, 2004 ("Petition for Revival"), and the "Renewed Petition to Revive Under 37 C.F.R. § 1.137(b)," ("Renewed Petition") was unintentional.

15. Finally, from March 24, 2004, when we first received and were notified of the Notice of Abandonment dated March 12, 2004, to June 17, 2004, when we filed our Petition for Revival, to the current filing of the Renewed Petition, I have been working with due care and diligence to revive this application.

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further, that these statements were made with the knowledge that willful false statements and the like so made are

punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the application, any patent issuing thereon, or any patent to which this verified statement is directed.

Dated: January 27, 2005

By: 

François David





# EXHIBIT 1



AARON M. RAPHAEL  
202.408.4152  
Aaron.Raphael@finnegan.com

June 9, 2003

M. François David  
AVENTIS PHARMA S.A.  
Direction des Brevets - K2/144  
20 Avenue Raymond Aron  
F-92160 Antony Cedex  
FRANCE

VIA FACSIMILE

U.S. Patent Application No. 09/742,008  
Inventor: Christian VISKOV  
Title: Novel Process for Preparing Cyclosporin  
Derivatives  
Your Reference: ST 98018  
Our Reference: 03806.0488-00000

Dear François:

We received a call from the Examiner responsible for the above-identified case, restricting the claims into five groups: group I (claims 1-14 and 22-23), group II (claims 15-16), group III (claims 17 and 19-20), group IV (claim 18), and group V (claim 21). Further, the Examiner required that we elect one specific compound as a starting point for examination as well. Please let us know which group and what specific compound you wish for us to elect. In the alternative, we can request that the Examiner present the restriction requirement in writing if you prefer. In either case, we will traverse the restriction requirement since it is not an undue burden to examine all the claims together.

If you have any questions regarding this restriction requirement, please contact me at your convenience.

With best regards,

Sincerely,

Aaron M. Raphael

AMR

## EXHIBIT 2



**From:** <Francois.David@aventis.com>  
**To:** <Aaron.Raphael@finnegan.com>  
**Date:** 6/13/03 9:21AM  
**Subject:** U.S. Patent Appln. S.No 09/742,008 - Your Ref. 03806.0488-00000 - Our Case ST98018

Dear Mr Raphael,

We have received your letter dated June 9, 2003.

You should have been informed in November 2002 that we were willing to abandon this application. Our file has been stored outside and we dont have the instructing letter here, but could you please check your own file and keep us informed?

Thank you in advance.

With kind regards,

François DAVID  
Aventis Pharma SA  
Patent Department France  
Phone : 33 1 49915627 Fax : 33 1 49914610  
francois.david@aventis.com

# EXHIBIT 3



**From:** <Francois.David@aventis.com>  
**To:** <Michele.Bosch@finnegan.com>  
**Date:** 4/8/04 10:03AM  
**Subject:** Re: US Patent Appln. S No 09/742,008 - Your ref. 03806.0488 - Our case ST98018/US

Dear Michele,

We received from you on September 20, 2002 a letter regarding the Status Inquiry.

I have just received a letter from Mr Chapman to which is attached a Notice of Abandonment date March 12, 2004. Accordind to the Notice the reason would be the applicant's failure to timely file the response to the Office letter mailed on 25 June 2003.

We have no trace in our file of such an Office letter...

Please note that this case is important since we may be licencing it in a few months. Discussions are currently in progress with a third firm.

Could you please let me know as soon as possible what could be the reason for this situation and eventually what could be done to overcome the problem?

Many thanks for your help\$

With kind regards,

François

> François DAVID  
> Aventis Pharma SA  
> Patent Department France  
> Phone : 33 1 55 71 44 10  
> Fax : 33 1 55 71 72 91  
>     Francois.david@aventis.com  
>

# EXHIBIT 4





AARON M. RAPHAEL  
202.408.4152  
Aaron.Raphael@finnegan.com

June 13, 2003

M. François David  
AVENTIS PHARMA S.A.  
Direction des Brevets - K2/144  
20 Avenue Raymond Aron  
F-92160 Antony Cedex  
FRANCE

**VIA FACSIMILE**

U.S. Patent Application No. 09/742,008  
Inventor: Christian VISKOV  
Title: Novel Process for Preparing Cyclosporin  
Derivatives  
Your Reference: ST 98018  
Our Reference: 03806.0488-00000

Dear François:

Thank you for your email of June 13, 2003. We have no record of your November 2002 correspondence indicating that you requested that the application be abandoned. Further to your instruction in your email, however, we will update our docket to reflect that we will be abandoning the above-identified application. Accordingly, we will close our file for this matter.

It has been a pleasure working with you on this matter.

With best regards,

Sincerely,

Aaron M. Raphael

AMR



# EXHIBIT D





1300 I Street, NW ■ Washington, DC 20005-3315 ■ 202.408.4000 ■ Fax 202.408.4400  
www.finnegan.com

ERNEST F. CHAPMAN  
202.408.4096



March 24, 2004

M. Francois David  
AVENTIS PHARMA S.A.  
Direction de Brevets - LE0/144  
20 Avenue Raymond Aron  
F-92160 Anthony Cedex  
FRANCE

U.S. Patent Application No. 09/742,008  
Inventor: Christian VISKOV  
Your Reference: ST 98018  
Our Reference: 03806.0488

Dear Mr. David:

Enclosed is a copy of the Notice of Abandonment dated March 12, 2004, from the United States Patent and Trademark Office for the above-identified application.

With best regards,

Sincerely,

  
Ernest F. Chapman

EFC/cma  
Enclosure

cc: Carol P. Einaudi